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REMARKS

In the Office Action of August 25, 2004, Examiner rejected claims 1-3, 6-8, 18 and 26 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,499,353 to Douglas et al. ("Douglas"). Examiner further rejected claims 4-5, 9-11 and 19-21 under 35 U.S.C. §103 as being unpatentable over Douglas in view of U.S. Patent No. 4,071,714 to Satoh ("Satoh"). However, Examiner allowed claims 16 and 17, and indicated that claims 12-15 and 22-25 would be allowable if re-written in independent form including recitations from the claims from which they depend.

Applicant traverses rejection of claims 1-3, 6-8, 18 and 26 under 35 U.S.C. 102(e) as follows. An aspect of Applicant's invention as claimed in independent claims 1, 2, 16, 18 and 26 is to provide an indication of a state of electric circuitry in an environmentally sealed enclosure. To further clarify Applicant's field of invention, Applicant herein amends claims 1-4, 16 and 26 to replace the term "electrically operated circuitry" with --electric circuitry--. No new subject matter is added by the amendments. Exemplary support for the amendment is provided in Figures 1 and 4 of the application.

Meanwhile, Douglas does not teach having any electric circuitry inside its sealed container. In particular, while the Examiner characterized transmitter 12 of Douglas as "electrically operated circuitry", Applicant submits that this characterization is incorrect. In fact, transmitter 12 is simply just a magnetically operated mechanism comprising a transducer and a magnetic field generator. See for example Figure 1 and column 4, lines 9-14 of Douglas. Notably, Douglas also teaches away from having any electric circuitry inside the container (see for example column 1, lines 33 to 34 of Douglas: "...electrical sensors cannot or are not easily or safely implemented or used [inside the container]"). As such, Douglas does not teach having an

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electric circuit inside its sealed container and Applicant thus respectfully submits that independent claims 1, 2, 16 and 26, and all claims dependent therefrom, are not anticipated Douglas.

Examiner further rejected claim 18 as anticipated by Douglas since "the method steps would have been inherent in the product structure as stated in claims 1 and 6-8". Applicant respectfully notes that claim 18 is an apparatus claim directed to a visual indication device. Among other things, claim 18 states that a magnetic flux sensor and a visual indicator are environmentally sealed within a common carrier and electrically connected within the common carrier. This aspect is not taught or suggested in Douglas. Douglas only teaches a visual indicator that is outside the sealed container (see for example figure 2 of Douglas), and does not

Examiner also rejected claims 4-5, and 9-11 under 35 U.S.C. §103 as being unpatentable over Douglas in view of Satoh, and further objected to claims 12-15 under 35 U.S.C. §103 as being depending from a rejected base claim. Applicant traverses the rejection and objection as follows. Claims 4-5 and 9-15 depend indirectly from claim 1 and define an environmentally sealed enclosure for electric circuits, as noted above. Meanwhile, Douglas is directed to an apparatus for measuring the pressure or other physical quality of a gas or liquid in a sealed container, and also provides no motivation to combine this with art relating to electric circuits. In particular, a specified application of the container of Douglas is for storage of spent nuclear fuel or radioactive mixed waste, where use of electric circuits, such as electrical sensors, "cannot or are not easily or safely implemented" inside the container (see column 1, lines 23 to 33 of Douglas). Further, Douglas teaches that it is undesirable to have electric circuits inside the sealed container and that one of its objectives is to provide a container without such electric

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circuits therein (see for example column 2, lines 55 to 56 and 59 to 60, and column 3 lines 21 to 23 of Douglas).

It is well-established that in gathering relevant prior art there must be some motivation to combine the pieces of prior art cited. When a cited piece of prior art "teaches away" from the claimed invention, it cannot be used as a relevant reference. See the general "teach away" doctrine as per *Gillette Co. v. S.C. Johnson & Sons, Inc.*, 919 F.2d 720, 724, 16 USPQ2d 1923,1927 (Fed. Cir. 1990), where the closest prior art reference "would likely discourage the art worker from attempting the substitution suggested by [the inventor/patentee]." The courts have clearly noted that such references which teaches away cannot be included as relevant prior art. See *McGinley v. Franklin Sports, Inc.* 262 F.3d 1339, 1354, 60 USPQ2d 1001 (Fed. Cir. 2001): "We have noted ... as a 'useful general rule,' that references that teach away cannot serve to create a prima facie case of obviousness" [emphasis added].

Since Douglas explicitly teaches away from having electric circuits within its sealed container, it is inappropriate to combine Douglas with art suggesting use of electric circuits, such as the electrical signal transmitter of Satoh, to arrive at Applicant's claims 4-5 and 9-15. Since neither Douglas nor Satoh alone teaches or suggests the features of such claims, and since Douglas teaches away from combination with Satoh, claims 4-5 and 9-15 are patentable over Douglas and Satoh pursuant to 35 U.S.C. §103.

Finally, Examiner also rejected claims 19-21 under 35 U.S.C. §103 as being unpatentable over Douglas in view of Satoh, and objected to claims 22-25 as being depending from a rejected claim. Applicant respectfully traverses the rejection and objection. Claims 19-25 depend from claim 18, which as noted above is directed to a visual indication device having a magnetic flux sensor and a visual indicator that are environmentally sealed within a common carrier and electrically connected within the common carrier. Neither the receiver apparatus of Douglas nor the signal receiver of Satoh has a visual indicator or flux sensor that is environmentally sealed

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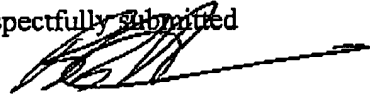
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within a common carrier. Since neither reference teaches or suggests this aspect of having a visual indicator and a magnetic flux sensor environmentally sealed in a common carrier, claims 19-25 are patentable over Douglas and Satoh pursuant to 35 U.S.C. §103.

For at least the above reasons, Applicant respectfully requests that the rejections under 35 U.S.C. §102(e) and §103 be withdrawn against the claims.

No new subject matter is provided with the present amendments. In view of the above remarks, Applicant submits that the claims are in condition for allowance. Applicant earnestly solicits that this application be permitted to proceed to allowance. The Examiner is invited to contact the undersigned by telephone to discuss this case further, if necessary.

Respectfully submitted

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Date

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